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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/916,937      | 07/27/2001  | Paul Lubock          | 26684-1250          | 9292             |

7590 06/04/2003  
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Coudert Brothers LLP  
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600 Beach Street  
San Francisco, CA 94109

EXAMINER

MARMOR II, CHARLES ALAN

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

3736

DATE MAILED: 06/04/2003

10

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/916,937

Applicant(s)

LUBOCK ET AL.

Examiner

Charles A. Marmor, II

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) 5-17, 21-26, 28-30, 32-39 and 41-44 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 18, 19, 27, 31 and 40 is/are rejected.
- 7) ☒ Claim(s) 20 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6, 7.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

### **DETAILED ACTION**

1. This Office Action is responsive to the Response to Election of Species Requirement filed March 17, 2003. The Examiner acknowledges the election to prosecute Species I directed to Figures 1A-1D, 3A and 3B. Claims 1-4, 18-20, 27, 31 and 40 read on the elected species.

#### ***Election/Restrictions***

2. Claims 5-17, 21-26, 28-30, 32-39 and 41-44 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 10.

#### ***Specification***

3. The disclosure is objected to because of the following informalities: in paragraphs [0001] and [0052], the current status of the cited applications apparently should be updated. Appropriate correction is required.

4. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-4, 18, 19, 27, 31 and 40 are rejected under 35 U.S.C. 102(b) as being anticipated by Mollenauer ('418). Mollenauer teaches elongated tissue removing devices for harvesting blood vessels. The devices include an elongate shaft with a region for securing a tissue mass on a distal shaft section; and a tissue expander or dilation device on the elongate shaft proximal to the tissue securing region to facilitate removal of a tissue mass. The tissue expander comprises an inflatable balloon that is attached to the elongate shaft proximal of the region for securing a tissue mass. The distal tip of the shaft is pointed, forming a cutting surface capable of penetrating tissue. The region for securing a tissue mass includes an anchoring member formed by an elongate balloon that is configured to deploy into tissue. The devices may be provided as a unit or as a plurality of elements in a kit that are assembled to form the device.

***Allowable Subject Matter***

7. Claim 20 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. The following is a statement of reasons for the indication of allowable subject matter: No prior art of record teach or fairly suggest a tissue removal device including a shaft having a tissue securing region and a tissue expander/dilation device disposed on the shaft proximal to the tissue securing region, where the tissue securing region is formed by an elongated electrosurgical anchor element that is configured to deploy into tissue.

### *Conclusion*

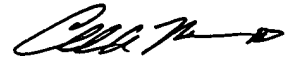
9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Andrews et al. ('178) teach a localization device with anchoring bars. Bonutti (365) teach mechanically expandable arthroscopic retractors. Burbank et al. (429) teach an electrosurgical lesion location device. Burbank et al. ('695) teach a biopsy anchor device with a cutter.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles A. Marmor, II whose telephone number is (703) 305-3521. The examiner can normally be reached on M-TH (7:00-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (703) 308-3130. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9323 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.



Charles A. Marmor, II  
Primary Examiner  
Art Unit 3736

cam  
May 30, 2003